

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In Re: Patent Application of Charles A. Eldering**

Conf. No.: 9427 : Group Art Unit: 2623  
Appln. No.: 09/204,888 : Examiner: Kieu Oanh T. Bui  
Filing Date: 03 December 1998 : Attorney. Docket No.: T702-00  
Title: Subscriber Characterization System

**APPLICANT'S COMMENTS ON STATEMENT OF REASONS FOR  
ALLOWANCE UNDER 37 CFR 1.104(e)**

Responsive to the Examiner's Statement of Reasons for Allowance, included with the Notice of Allowance dated August 22, 2006, and the Supplemental Notice of Allowance dated October 11, 2006, and concurrent with payment of the Issue Fee in the above-identified patent application, please consider the following remarks:

### REMARKS

The following Remarks are made with respect to the Examiner's Statement of Reasons for Allowance, at pages 3-4 of the Notice of Allowability and at pages 2-3 of the Supplemental Notice of Allowance ("Statement").

Rule 1.104(e) and MPEP 1302.14 permit the Examiner to set forth a written statement of reasons for allowance under certain circumstances. MPEP 1302.14 expressly provides that "(t)he statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth." While the Examiner's Statement sets forth at least one reason for allowance, Applicant expressly reserves the right to assert in any future proceedings regarding this application or any patent(s) issuing directly or indirectly therefrom, the allowability and/or allowance of the claim(s) on the basis of any other reason(s) consistent with the prosecution history of the application.

Additionally, MPEP 1302.14 requires the statement to be "accurate". However, the Examiner's statement is factually incorrect, because the Examiner misrepresents the teaching of U.S. Patent No. 5,758,257 to Herz *et al.* ("Herz").

The Examiner states that Herz "creates a scheduling of programs/events based on predetermined classes of viewers, i.e., for Dad or for Mom or for the child..." (see Notice of Allowance page 4). Herz does not teach creating scheduling for particular "classes" or individuals that could be termed Mom or Dad. In fact, Herz is not concerned with the class of viewers or their particular identity as Mom or Dad. Instead, Herz is concerned with classifying viewers in terms of "characteristics", which may "include any descriptive features suitable in describing particular video programs, such as classification category; directors; actors and actresses; degree of sex and/or violence; and the like," (see Herz, column 4, lines 64-67). Thus, the Examiner's assertion that Herz relies on "classes of viewers" to create scheduling is misleading, and is therefore inaccurate. Herz does not determine scheduling based on predetermined classes of

viewers, i.e. for Dad, but instead determining scheduling based on a profile having likings for particular descriptive features “suitable in describing video programs.”

Further, the schedules are not necessarily appropriate for a class of viewers such as Mom or Dad, as described by the Examiner, but instead are appropriate for the collected profile that represents an actual viewer. Since the Statement is factually incorrect in at least the aforesaid instances and since such inaccuracies are contrary to both the spirit of the Rule and the express provisions of the MPEP, Applicant(s) deny acquiescence to such reasons and further deny being bound by any negative inferences that may flow therefrom in any future proceedings regarding this application or any patent(s) issuing directly or indirectly therefrom.

Additionally, Rule 1.104(e) limits the Examiners’ ability to provide a statement of reasons for allowance to some degree. The rule states, in pertinent part:

If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the Examiner may set forth such reasoning.

Consequently, where the statement of reason(s) does not clarify the reason(s) for allowance over the prosecution record (or actually further confuses the record), the statement violates Rule 1.104(e). As noted above, since the Examiner’s statement misrepresents the teachings of Herz, the Examiner’s Statement does not further clarify the record. Accordingly, since the Examiner’s Statement violates Rule 1.104(e), it is of no legal effect.

For the foregoing reasons, Applicant therefore denies acquiescence to such Statement and further denies being bound by any negative inferences that may flow therefrom in any future proceedings regarding this application or any patent(s) issuing directly or indirectly therefrom.

Respectfully submitted,

Date: 10/13/06

By: Andrew W. Spicer

Andrew W. Spicer  
Registration No. 57,420  
Technology, Patents & Licensing, Inc.  
2003 South Easton Road, Suite 208  
Doylestown, PA 18901  
Telephone: 267-880-1720  
Customer No. 27832